

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KHUY V. NGUYEN
DONALD K. SIMMONS
RONALD W. CALL and SHAWN E. HUX

Appeal 2006-0868
Application 10/005,846
Technology Center 1700

Decided: September 8, 2006

Before WARREN, TIMM, and FRANKLIN, *Administrative Patent Judges*.

FRANKLIN, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

A review of the record presently before us leads us to conclude that this case is not in condition for a decision on appeal. Accordingly, we remand the Application to the Examiner, via the Office of a Director of the involved Technology Center, to consider the following issues and to take action not inconsistent with the views expressed herein.

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The Examiner maintains two rejections on appeal. Claims 1-3 and 6-11 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Kondo. Claims 4 and 5 stand rejected under 35 U.S.C. § 102(b) as being anticipated by or in the alternative under 35 U.S.C. § 103 as being obvious over Kondo. A copy of each of these claims is set forth in the attached appendix.

The Examiner relies upon the following reference as evidence of unpatentability:

Kondo (as translated) JP 10-017694 Jan. 20, 1998

We specifically address the rejection of claims 1-3 and 6-11 under 35 U.S.C. § 102(b) as being anticipated by Kondo. Claim 1 recites an elastomer amount of “less than 10 percent by blend weight.” Claims 2 and 10 each recites an elastomer amount of about 2 to 10 percent by blend weight. Claims 3, 8, and 11 each recites an elastomer amount of about 3 to 7 percent by blend weight.

Kondo teaches an elastomer amount of “no more than 30%” (Kondo, para. 13).

On pages 3-4 of the Reply Brief, Appellants raise the issue that there is no rejection of claims 1-3 and 6-11 under 35 U.S.C. § 103. At the top of page 4, Appellants point out that the claim (claim 1, e.g.) recites an elastomer amount of “less than 10 percent by blend weight.”

While Appellants focus on the preamble of the claim regarding an increase in mechanical strength, we remand this application to the Examiner

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to address the more important issue of whether Kondo's teaching of an elastomer amount of "no more than 30%" anticipates and/or makes obvious Appellants' aforementioned claimed ranges. In so doing, it is necessary that the Examiner review the cases of *Atofina v. Great Lakes Chemical Corp.*, 441 F.3d 991, 999, 78 USPQ2d 1417, 1423 (Fed. Cir. 2006); *Perricone v. Medicis Pharmaceutical Corp.*, 432 F.3d 1368, 1372, 77 USPQ 2d 1321, 1326 (Fed. Cir. 2005); *Titanium Metals Corp. of Am. v. Banner*, 778 F.2d 775, 780, 227 USPQ 773, 777 (Fed. Cir. 1985) ("[A]nticipation under § 102 can be found only when the reference discloses exactly what is claimed and that where there are differences between the reference disclosure and the claim, the rejection must be based on § 103 which takes differences into account. D Chisum, *Patents* § 3.02."); *In re Malagari*, 499 F.2d 1297, 1303, 182 USPQ 549, 552 (CCPA 1974); and *In re Reven*, 390 F.2d 997, 1001, 156 USPQ 679, 681 (C.C.P.A. 1968).

In summary, the instant application is remanded to the Examiner to consider the aforementioned issues and to act accordingly. This remand to the Examiner pursuant to 37 C.F.R. § 41.50(a)(1) is made for further consideration of a rejection. Accordingly, 37 C.F.R. § 41.50(a)(2) applies if a Supplemental Examiner's Answer is written in response to this remand by the Board.

REMAND

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APPENDIX

1. A method of improving the mechanical strength of a membrane comprising the step of:

providing a microporous sheet comprising a blend of an aliphatic polyolefin and a thermoplastic olefin elastomer selected from the group of ethylene-propylene rubbers, ethylene-propylene-diene terpolymer rubbers, and combinations thereof with the elastomer comprising less than 10 percent by blend weight.
2. The method of Claim 1 wherein the elastomer comprises about 2 to 10 percent by blend weight.
3. The method of Claim 2 wherein the elastomer comprises about 3 to 7 percent by blend weight.
4. The method of Claim 1 wherein the microporous sheet has a Gurley air permeability less than 35 seconds/10cc.
5. The method of Claim 4 wherein the microporous sheet has a Gurley air permeability less than 25 seconds/10cc.
6. The method of Claim 1 wherein the polyolefins selected from polyethylene, polypropylene, copolymers thereof, and blends thereof.

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7. The method of Claim 1 wherein the thermoplastic olefin elastomer is selected from the group of ethylene-propylene rubbers, ethylene-propylene-diene terpolymer rubber, and combinations thereof.

8. A method of improving the mechanical strength of a membrane comprising the step of:

providing a microporous sheet having a Gurley air permeability less than 35 seconds/10cc comprising a blend of an aliphatic polyolefin selected from the group consisting of polyethylene, polypropylene, copolymer thereof, and blends thereof, and a thermoplastic olefin elastomer being selected from the group consisting of ethylene-propylene rubbers, ethylene-propylene-diene terpolymer rubbers, and combinations thereof, with the elastomer comprising 3 to 7 percent by blend weight.

9. A diffusion membrane comprising:

a dry stretched microporous sheet comprising a blend of an aliphatic polyolefin and a thermoplastic olefin elastomer, the elastomer comprising less than 10 percent by blend weight, the polyolefin being selected from the group consisting of polyethylene, polypropylene, copolymers thereof, and blends thereof, the thermoplastic olefin elastomer being selected from the group consisting of ethylene-propylene rubbers, ethylene-propylene-diene terpolymer rubbers, and combinations thereof.

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10. The membrane of Claim 9 wherein the elastomer comprises between 2 and 10 percent by blend weight.
11. The membrane of Claim 10 wherein the elastomer comprises between 3 and 7 percent by blend weight.